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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,465	08/14/2001	Jeff Kirsner	HALB:020	9062

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EXAMINER	
TUCKER, PHILIP C	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/929,465	KIRSNER ET AL.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-16,18-41,43-51 and 53-89* is/are pending in the application.

4a) Of the above claim(s) *59-80 and 86-89* is/are withdrawn from consideration.

5)☒ Claim(s) *4* is/are allowed.

6)☒ Claim(s) *1,3,5-16,18-41,43-51,53-58 and 81-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 12. 13, 25, 26, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims teach that the ester is made from internal olefins, which is not supported by the specification as originally filed, and is thus new matter.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 50, 51, 53-55, 57, 58 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/26386.

WO teaches an invert emulsion drilling fluid which comprises a triglyceride ester oil in admixture with another ester, wherein the triglyceride ester and ester are within the scope of the present invention (see page 4, lines 8-15, page 4, line 29 – page 5, line 9 and Table 3). Applicants method of making the ester does not distinguish, since in product by process claims, the process of making does not distinguish the product (In re Thorpe 227 USPQ 964).

3. Claims 1, 3, 5-9, 12-16, 18-22, 25-28, 30-33, 36-38, 43, 44, 48-49 and 81-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel (US 2001/0009890 A1).

Patel teaches an invert emulsion drilling fluid which comprises esters and a C16-C18 isomerized internal olefin (see the examples). Patel further teaches the combination of various esters and hydrocarbons, such as mineral oils (see claims 1 and 9). Such mineral oils would comprise paraffins according to the present invention. Combinations of glycerides of fatty acids and esters are taught at paragraph [0018]. Applicants method of making the ester does not distinguish, since in product by process

claims, the process of making does not distinguish the product (In re Thorpe 227 USPQ 964).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 10, 11, 14, 23, 24, 38-41, 45-47, 56, 81, 82 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (US 2001/0009890 A1) in view of Mueller (6165946) and Rines H935.

Patel teaches an invert emulsion drilling fluid which comprises esters and a C16-C18 isomerized internal olefin (see the examples). Patel further teaches the combination of various esters and hydrocarbons, such as mineral oils (see claims 1 and 9). Such mineral oils would comprise parrafins according to the present invention. Combinations of glycerides of fatty acids and esters are taught at paragraph [0018]. Patel differs from the present invention in that the use of 2-ethylhexanol in the formation of the esters is not disclosed, and the specific composition of the mineral oil is not disclosed. The use of 2-ethylhexanol would be obvious to one of ordinary skill in the art, given the teaching of Patel that alcohols of C1-12 length may be used in the formation of the esters (claim 1), particularly in view of the teaching of Mueller that esters made from 2-ethylhexanol may be used in invert emulsion drilling fluids (see first Table in

column 22). The use of low aromatic mineral oils as the continuous phase of an invert emulsion drilling fluid is taught by Rines (column 4, line 45-58 shows less than 0.5 wt% aromatic), which improves environmental compatibility. Thus the use of a low aromatic mineral oil in the invert emulsion of Patel, such as that taught by Rines, comprising paraffins and/or olefins of low carbon chain length in order to protect the environment would be an obvious variation to one of ordinary skill in the art, particularly in view of the teaching of a low toxicity mineral oil by Patel [0069].

6. Claims 27-37 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (5569642) in view of Mueller (6165946).

Lin teaches the use of a mixture of linear and branched paraffins for use as the continuous phase of a drilling fluid. Lin teaches that the paraffin mixture may be used in combination with an ester in order to improve the performance of the fluid or lower costs (column 3, lines 39-43). Lin differs from the present invention in not disclosing an example of such esters. Mueller teaches the use of ester oils as the continuous pahse of a drilling fluid, which comprises esters of 2-ethylhexanol (column 22). It would be obvious to one of ordinary skill in the art to use known drilling fluid ester formulations, such as that of Mueller, in the drilling fluid of Lin, given the teaching of Lin that esters may be used therein in order to improve drilling performance, or lower cost.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3, 5-7, 14-16, 18-23, 25 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 10/175272 (now allowed). Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claim of 10/175272 differs in teaching other ingredients of the drilling fluid, it teaches the same ester and olefin in the invert emulsion drilling fluid of the present invention, and would render the claims of the present invention obvious to one of ordinary skill in the art. The variation of the amounts of ester to olefin as in claims 6 and 7, in order to optimize the properties of the drilling fluid, such as rate of penetration, would be an obvious variation to one of ordinary skill in the art. Applicants method of making the ester does not distinguish, since in product by process claims, the process of making does not distinguish the product (In re Thorpe 227 USPQ 964)..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim 4 is allowable over the art of record.

10. Applicants arguments and amendments have been considered but are not deemed persuasive. The rejections over Mueller '434 and WO '386 with respect to claims 1, 5-9, 12-14, 18-22, 25 and 26 have been removed, since the olefin is specified as being an internal olefin.

In traversing the rejection over Patel under 35 USC 102, applicants arguments are that Patel teaches fluids with "negative alkalinity" and are thus not identical with the present invention. Patel however meets every limitation of the present claims and teaches fluids with "negative alkalinity", and comparative fluids which comprise lime and are thus positively alkaline (see Table 7). There is no teaching in applicant's claims which distinguish over the teachings of Patel, since Patel meets every limitation of applicants claims. The courts have held that all limitations of the claim must be met for anticipating (In re Arhley 172 USPQ 524, In re Royku 180 USPQ 580). All limitations of the claims are met by Patel, since an ester in combination with an internal olefin or other hydrocarbon comprising the base of an invert emulsion is taught therein. Thus anticipation is established. There is no precedent for the claim having to meet all the limitations of the reference, as applicant is trying to establish in stating that the fluids of Patel have negative alkalinity, and are thus distinguishable. Contrary to applicants assertion, the teachings of Patel and of applicants claims are "identical" for purposes of anticipation. The fact that Patel teaches that the fluid having negative alkalinity performs

better than that which is positively alkaline, cannot distinguish when considering anticipation. With respect to the 35 USC 103 rejection over Patel, applicant has argued that an obvious to try standard has been used. The use of low aromatic mineral oils in drilling fluid to protect the environment has been a well established practice in the art. Thus the use of a low aromatic mineral oil in the invert emulsion of Patel, such as that taught by Rines, comprising paraffins and/or olefins of low carbon chain length in order to protect the environment would be an obvious variation to one of ordinary skill in the art, particularly in view of the teaching of a low toxicity mineral oil by Patel [0069]. Applicant has argued that the esters used in the present invention differ from those used by Patel, and a different problem is solved by using them. However, the scope of the esters used by Patel clearly overlaps in scope with those used by the present invention. Even though Patel may try to solve a particular problem, case law has held that the difference for adding a material to a composition is not a patentable distinction (In re Lindner 173 USPQ 580, In re Mod 168 USPQ 281).

Applicant has also argued the validity of the rejection of Lin in view of Mueller. Lin clearly provides motivation to use esters, given the teaching of Lin that esters may be used therein in order to improve drilling performance, or lower cost. One of ordinary skill in the art would clearly look to the teachings of the prior art of invert emulsion drilling fluids to determine the scope of the esters which may be used in the drilling fluid of Lin. One of ordinary skill in the art does not operate in a vacuum devoid of the prior art teachings. Unlike Lindemann Maschinefabrik, or Texas Instruments v. US intl Trade Commission cited by applicant, Lin clearly provides motivation, such as improved

drilling performance to look to the prior art to seek esters for such improvement. Applicant has argued that the examiner must show that the skilled artisan, confronted with the same problem, would select the same elements as in the manner claimed. Again, case law has held that the difference for adding a material to a composition is not a patentable distinction (In re Lindner 173 USPQ 580, In re Mod 168 USPQ 281). Applicant has also argued that the invention as a whole must be considered. Applicant has not submitted any secondary considerations, such as superior and unexpected results which could help to distinguish the current claims from the prior art. The rejections are thus maintained. A new obviousness double patenting rejection is presented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-3255